

REMARKS

This amendment adds new claims 7-12 having elements drawn to additional antibiotics, differing bacterial strains, oral administration, pharmaceutical carriers, tablet form, and tablet form dosage amounts.

Reconsideration of the application in view of both the above amendment and the following remarks is requested.

The Office Action rejects claims 4-6 under 35 U.S.C. §102 as being unpatentable over U.S. Patent 6,011,030 issued January 4, 2000 to Pfirrmann—hereinafter “Pfirrmann.”

In response to Applicant's argument that Pfirrmann is non-anticipating due to its failure to teach each of the recited claim elements—such as preventing transfer of plasmid materials containing genes capable of resisting vancomycin—the Examiner relies upon MPEP §2112.02. The Examiner asserts that the claims are only directed to a property of a known composition, and merely recite the newly discovered result of preventing the transfer of plasmid materials from bacteria to bacteria. However, it is not a *property* or a *result* that is instantly claimed, it is the *use* in humans and warm-blooded animals of taurolidine to prevent the molecular biological transfer of genes between differing strains of bacteria based upon the now better appreciated chemical behavior of taurolidine at the cellular level. Indisputably such new uses for known compounds based

on unknown properties of the known compound *are* patentable as process claims. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). *Accord* In re Hack, 245 F.2d 246, 248 (C.C.P.A. 1957). The specification fully describes the chemical machinations by which taurolidine interferes with bacterial cell wall constituents (page 5), such as F pili which are fine filaments along which plasmid materials containing genes capable of resisting vancomycin can be transferred from bacteria to bacteria (described at pages 8-9). Accordingly, the instant claims are *not* anticipated by Pfirrmann, and are patentable notwithstanding the invocation MPEP §2112.02.

In maintaining the §102 rejection the Examiner ignores a wealth of established case law, to thereby marginalize the art's failure to teach each element of the claims. It is beyond question that "to anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Industries, Inc., v. Guardian Industries Corporation, 75 F.3d 1558, 1566 (Fed. Cir. 1996). Insofar as a finding of anticipation **mandates** disclosure in a single prior art reference of each and every element as set forth in the claim, Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984), Pfirrmann *cannot* anticipate the instant claims, owing to its silence on the independent claim's elements of *capable genes, plasmids, or the host's harboring of bacteria that contain such materials*.

With regard to newly-presented dependent claim 7, Pfirrmann further fails to disclose the combination of taurolidine with any of gentamicin, methicillin, or vancomycin; indeed Pfirrmann repeatedly cautions that taurolidine should *not* be combined with antibiotics and cautions that antibiotic treatment should follow at a time

significantly after taurolidine treatment to avoid dangerous toxin release. Pfirrmann further fails to disclose anything regarding *S. aureus* that are vancomycin-intermediate susceptible (claim 8). And, the Pfirrmann taurolidine disclosures are exclusively directed to administrations that are intravenous or laproscopic; Pfirrmann teaches nothing about oral administration (claim 9), admixture with pharmaceutical carriers (claim 10), the use of tablet form (claim 11), or tablet dosage amount (claim 12). Accordingly, Pfirrmann is clearly non-enabling with regard *all* claims, and particularly non-enabling with regard to claims 9-12. Therefore Pfirrmann does not anticipate any of the instant claims. PPG Industries, Inc., *supra*.

There is ample antecedent support for the newly presented claims: claim 7 is supported at page 14-15; claim 8 is supported at page 14; claim 9 is supported at pages 14-16; claim 10 is supported at pages 14-15; claim 11 is supported at pages 15-16; and claim 12 is supported at page 16, Example 5.

In view of the foregoing, Applicant submits that claims 4-12 are not anticipated by the Pfirrmann reference. As the instant application appears to be in condition for allowance, Applicant requests its prompt passage to issue.

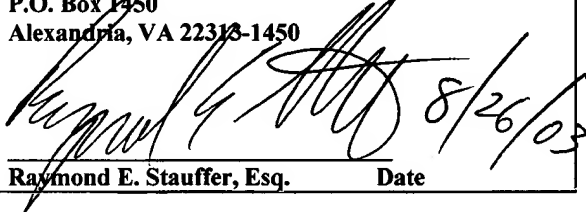
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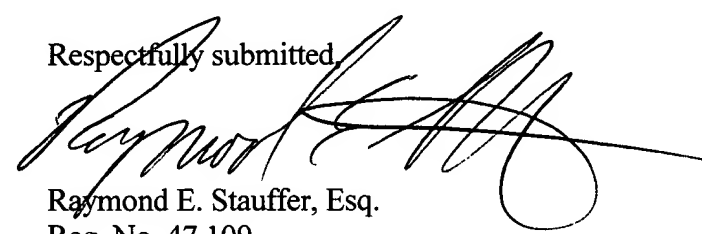
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P.O. Box 1450
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Raymond E. Stauffer, Esq.

8/26/03
Date

Respectfully submitted,


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